

**REMARKS**

Applicant has carefully reviewed the Office Action mailed on December 4, 2002, and notes with appreciation the substantive allowance of claims 16-28, 39, 40, 42-49, 52, 57-85, 94-97, 111-117, and 127-155. This Amendment document is submitted to address and fully overcome the rejections made in the Office Action, along with a Request to extend the response deadline one month, or to April 4, 2003. The Examiner is authorized to charge any fees required for processing the Amendment and Request documents to Deposit Account 11-0978.

In the Office Action, claims 156-160 are rejected under Section 112 of the Patent Act because they allegedly do “not set forth any steps involved in the method/process.” Applicant respectfully submits that the “step” is “using” the system recited in the corresponding claim for “pumping and mixing” a fluid, and that claims in this form have long been sanctioned by both the Board of Appeals and Interferences. For example, in *Ex Parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Int. 1992), the Board held that a claim reciting the single step of “utilizing” an apparatus set forth in a different claim does not lack definiteness. Specifically, the claim in question recited:

A method . . . which comprises utilizing the nozzle of claim 7.

In reversing the Examiner’s rejection under Section 112, the court stated that:

[t]he manner in which claim 6 has been drafted has been an acceptable format for years. The format of claim 6 apparently is used more often in chemically related applications; for example, note claim 11 reproduced in the decision of

*In re Kuehl*, 475 F.2d 658, 177 USPQ 250 (CCPA 1973)<sup>1</sup> and claims 11 and 14 reproduced in *Ex parte Blattner*, 2 USPQ2d 2047 (BPAI 1987).<sup>2</sup> ***Contrary to the examiner's assertion that claim 6 has no method step, the claim clearly recites the step of "utilizing."*** Such single-step method claims were present in *In re Kuehl*, *supra*, (contacting) and *Ex parte Blattner*, *supra*, (administering, in claim 14).

(emphasis added).

Just like claim 6 approved by the Board in *Ex Parte Porter*, claims 156-160 in the present application are directed to a method of ***pumping or mixing*** a fluid ***using*** the system of the corresponding claim. It is indisputable that the term "using" is synonymous with the "utilizing" step appearing in the single-step claim sanctioned by the Board in *Ex Parte Porter*. Therefore, it is respectfully submitted that the rejection of claims 156-160 as being indefinite under Section 112 is improper in accordance with this precedential Board decision and should be withdrawn.

As for the alternate basis of rejection of claims 156-159 (but not claim 160) as improper under Section 101 of the Patent Act, it is contended that "the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition

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<sup>1</sup> Claim 11 in that case recited "[a] hydrocarbon conversion process which comprises contacting a hydrocarbon charge under catalytic cracking conditions with the composition of claim 6.

<sup>2</sup> The claims at issue in this case recited as follows:

11. A pharmaceutical composition useful in the treatment of states of agitation in a warmblooded animal comprising a therapeutically effective amount of an azatetracyclic compound according to claim 17, or a pharmaceutically acceptable acid addition salt thereof together with a pharmaceutical carrier.

14. A method of treating states of agitation in a warmblooded animal which comprises administering to said animal a therapeutically effective amount of a compound according to claim 17, or a pharmaceutically acceptable acid addition salt thereof.

of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101.”

Clearly, this contention is specious in view of the holdings of *Ex Parte Porter, supra* and the case decisions cited by it, all of which expressly sanctioned a single step method of “using” a device as being proper. The cases cited in the Office Action as supporting the contention made are wholly distinguishable from the present situation and, thus, are not controlling. These cases merely stand for the proposition that a new use of a composition of matter known to be old should be set forth in the form of a process or method claim in order to be patentable. *Ex Parte Dunki*, 153 USPQ 678 (Bd. Pat. App. & Int. 1967) (affirming an objection to a claim directed to “[t]he use of” a composition of matter, and noting that “the Examiner insists that appellant’s alleged new use ***should be expressed in method form.***”); *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.C. DC 1966) (“new use of a composition of matter known to be old should be set forth in the form of a process or method claim in order to be patentable.”). The claims under rejection here (which are not “composition of matter” claims and are not directed to “the use” of anything *per se*) are clearly directed to a method including the single step of “using” (rather than just a “use”) and, hence, are not in contravention of the holdings of the cited decisions (and, in fact, are in accord with later, precedential decisions of the Board). Therefore, withdrawal of the rejections under Section 101 is in order.

Claims 1-8, 10-15, 50-51, 53-54, 125 and 126 in the application are also rejected as being unpatentable over certain claims in the present inventor’s issued U.S. Patent No.

6,416,215 based on the judicially-created doctrine of obviousness-type double patenting. The basis for these rejections is that the allegedly “conflicting” claims are “not patentably distinct from each other because *whereas the claims of the application are constructed with open language of ‘comprising’, the scope of the elements of the patented claims are readable upon all the elements of the application claims.*” (emphasis added). Applicant respectfully submits that, even if certain claims in the ‘215 patent are considered to “read on” or dominate the inventions recited in claims in the present application, this is not a legitimate basis for an obviousness-type double patenting rejection.

The fact that claims in a patent may “read on” or dominate claims in a later application has long been rejected as a proper basis for a double patenting rejection. For example, in reversing the Board’s affirmation of a double patenting rejection made on similar “domination” grounds, the Court of Appeals for the Federal Circuit in the precedential decision of *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986), explained that:

We reverse the board’s double patenting rejection . . . [because] [i]t has confused double patenting with “domination” which, by itself, does not give rise to “double patenting” . . . . By domination, we refer . . . to that phenomenon, which grows out of the fact that patents have claims, *whereunder one patent has a broad or “generic” claim which “reads on” an invention defined by a narrower or more specific claim in another patent*, the former “dominating” the latter because the more narrowly claimed invention cannot be practiced without infringing the broader claim. . . . This commonplace situation is not, per se, double patenting, as the board seemed to think. . . . *Domination is an irrelevant fact.*

(emphasis added); *see also In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964)

(reversing a Board decision on double patenting grounded on the fact that the later-filed

claim at issue was within the scope of the earlier-filed patented claim, stating that “*it is elementary that readability of a claim on the subject matter of another claim (domination) is neither determinative of the double patenting issue nor demonstrative that claims are directed to the same invention.*”) (emphasis added).<sup>3</sup> Indeed, the MPEP at Section 804 clearly explains that:

Domination and double patenting should not be confused. They are two separate issues. One patent or application “dominates” a second patent or application when the *first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself . . . cannot support a double patenting rejection.*

(emphasis added). Since the Examiner’s obviousness-type double-patenting rejection is based solely on the concept of domination in contravention of both the MPEP and precedential decisions of the Court of Appeals for the Federal Circuit, it is improper and must be withdrawn.

Rather than domination, the test for “*obviousness*” type double patenting (whether “one way or “two way”) first looks at whether the invention set forth in an application claim is an *obvious* variant of the invention disclosed in a claim of an issued patent. *Kaplan, supra*. To make a *prima facie* rejection, the Examiner must proffer evidence that the claims in the application are directed to an invention that is obvious in view of what is claimed in an

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<sup>3</sup> The holding of *In re Kaplan* was followed by the Board of Patent Appeals and Interferences in the more recent, but non-precedential decision of *Ex Parte Davis*, 56 USPQ2d 1434 (Bd. Pat. App. & Int. 2000), which limited the case of *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) to its facts (which are distinguishable from the facts of the present situation, since the claims in the present application do not “read on” any invention claimed in the issued patent).

issued patent. However, in formulating the rejection, “the disclosure of a patent cited in support of a double patenting rejection *cannot be used as though it is prior art, even where the disclosure is found in the claims.*” *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1271, 23 USPQ2d 1839 (Fed. Cir. 1992).

Taking claim 1 in the present application as an example, it requires, *inter alia*, a motive device for rotating the superconducting element. No mention is made of a motive device for rotating the superconducting element in claim 1 of the ‘215 patent (or any other claim for that matter), and not even a scintilla of evidence or argument is provided establishing that the invention of claim 1 in the application would be obvious in view of the invention of claim 1 in this patent (which it is plainly not, since it is reiterated that using a motive device to rotate a superconducting element is not expressly mentioned anywhere in the claims of the ‘215 patent, and using such a motive device in combination with the other elements of the claim is not taught or suggested anywhere in the prior art of record).

While claim 1 in the ‘215 patent may dominate claim 1 in the application (which, again, is not a proper basis for a double patenting rejection), claim 1 in the present application does not cover or “read on” the invention recited in claim 1 of this patent. Consequently, allowing claim 1 in the present application results in no *unjustified* timewise extension of the protection afforded by claim 1 in the ‘215 patent, which is precisely what the concept of double patenting is intended to prevent (although a timewise extension *per se* is not necessarily a controlling factor; see *In re Bratt*, 937 F.2d 589, 19 USPQ2d 1289 (Fed.

Cir. 1991) (recognizing that “[o]nly if the extension of the patent right is *unjustified* is a double patenting rejection appropriate” and that “[t]here are situations [such as the one here] where the extension is justified.”). The same analysis applies to claim 50, the only other independent claim under rejection for obviousness-type double patenting.

In view of the foregoing, it is respectfully submitted that the obviousness-type double patenting rejections of claims 1 and 50 over the corresponding claims in the ‘215 patent are improper and must be withdrawn. If the obviousness-type double patenting rejections of these independent claims are withdrawn, it follows that the double patenting rejections of the dependent claims must also be withdrawn.

Applicant also submits amendments to claims 111, 117, 123, 131, and 152, mostly to correct formal issues. The substantive allowability of the claims is not believed to be affected by the amendments. In addition, new claims 161-163 are presented for consideration. Since these new claims are directed to the same basic invention of the other claims (including those that stand substantively allowed) and are believed to distinguish over all prior art of record, their allowance is in order.

Finally, Applicant notes that, despite the fact that the PTO acknowledged receipt of the Supplemental Information Disclosure Statement submitted on September 10, 2002, the Examiner did not acknowledge consideration of and include a copy of the corresponding form SB/08A with the Office Action dated December 4, 2002. Formal acknowledgment of the consideration of this Statement and the references cited therein is respectfully requested.

In summary, Applicant has addressed and overcome all issues raised in the Office Action dated December 4, 2002. Since it is believed that all claims are now in condition for allowance, including the new claims, an early notice to this effect is earnestly solicited. However, if the Examiner determines that some minor or formal issue prevents the issuance of the Notice of Allowance, please contact the Applicant's Counsel at the following telephone number.

Respectfully submitted,

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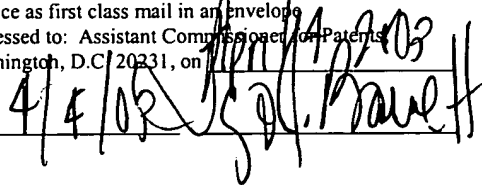
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**VERSION OF AMENDMENTS SHOWING CHANGES MADE**

Please amend claim 111 as follows:

111. (Amended) A method of levitating and rotating a magnetic pumping or mixing element for pumping or mixing a fluid, comprising:

placing the magnetic pumping or mixing element in the vessel;

levitating the magnetic pumping or mixing element [above] using a superconducting element positioned in an evacuated or insulated chamber adjacent to the vessel and thermally linked to a cooling source; and

rotating the superconducting element to induce rotation in the magnetic pumping or mixing element in the vessel.

Please amend claim 117 as follows:

117. (Amended) A method of levitating and rotating a magnetic pumping or mixing element for pumping or mixing a fluid, comprising:

placing [a] the magnetic pumping or mixing element in the vessel;

levitating the magnetic pumping or mixing element in the vessel using a superconducting element; and

rotating the magnetic pumping or mixing element using a driving magnet positioned adjacent to and concentric with the superconducting element.

Please amend claim 123 as follows:

123. (Amended) A method of levitating and rotating a magnetic pumping or mixing

element for pumping or mixing a fluid in a vessel, comprising:

placing the magnetic pumping or mixing element in the vessel;

levitating the magnetic pumping or mixing element [above] using a superconducting element positioned in an evacuated or insulated chamber adjacent to the vessel and thermally linked to a cooling source;

rotating the magnetic pumping or mixing element in the vessel; and

moving the superconducting element relative to the vessel,

whereby the rotating magnetic pumping or mixing element follows the movement of the superconducting element to ensure that effective, non-localized pumping or mixing action is provided.

Please amend claim 131 as follows:

131. (Amended) A system for pumping or mixing a fluid in a vessel, comprising:

a magnetic rotor or impeller for placement in the vessel, either before or after the fluid is introduced, said rotor or impeller including at least one pair of alternating polarity driven magnets;

at least one superconducting element for levitating said magnetic [pumping or mixing element] rotor or impeller and forming a magnetic coupling with said alternating polarity driven magnets;

a cryostat including an evacuated or insulated chamber in which the superconducting element is positioned, said chamber thermally isolating the superconducting

element from the vessel;

a cooling source thermally linked to said superconducting element; and

a motive device for rotating said superconducting element to induce rotation in the levitating impeller or rotor via the magnetic coupling.

Please amend claim 152 as follows:

152. (Amended) A method of levitating and rotating a magnetic pumping or mixing element for pumping or mixing a fluid, comprising:

placing the magnetic pumping or mixing element in the vessel;

levitating the magnetic pumping or mixing element [above] using a superconducting element;

forming a magnetic coupling between the pumping or mixing element and the superconducting element; and

rotating the superconducting element to induce rotation in the magnetic pumping or mixing element in the vessel as a result of the magnetic coupling.